

## **REMARKS**

### ***Summary of the Office Action***

In the final Office Action dated August 14, 2007, claims 1, 2, 5-9, 12, 14, 15, and 18-22 were pending, of which claims 1, 2, 5-9, 12, 14, and 18-22 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. patent No. 7,162,635 B2 to Bisbee et al. (herein Bisbee), and claim 15 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bisbee in view of U.S. patent No. 5,982,891 to Ginter et al. (herein Ginter).

### ***Summary of the Amendment***

Upon entry of this Amendment, claims 24-27 will have been added to the application. Accordingly, claims 1, 2, 5-9, 12, 14, 15, 18-22, and 24-27 are currently pending, of which claims 1, 2, 5, 7, 12, 15, 18, and 20 are currently amended, claims 6, 21, and 22 are previously presented, and claims 8, 9, 14, and 19 are original. The rejections of claims 1, 2, 5-9, 12, 14, and 18-22 under 35 U.S.C. § 102(e) and claim 15 under 35 U.S.C. § 103(a) under are respectfully traversed.

### ***Patentability over Bisbee and Ginter***

Claims 1, 2, 5-9, 12, 14, and 18-22 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Bisbee. Applicant respectfully traverses.

In items 1 and 2, the Office Action asserts that: “Bisbee teaches and suggests generating modification information for modifying original data, creating modification assuring information (column 14, lines 5-9) and outputting the original data, that data assuring information, the modification information and the modification assuring information (column 6, lines 57-59). The creating the modification assuring information is done as the modified document is loaded into the TCU. The transfer agent performs all of the checks on the modified document that was performed on the original document (column 13, lines 31-53). The modified document becomes an e-original (column 14, line 8). Outputting all of this data is done when the TCU exports the validated e-originals (both original and modified) which inherently include the assuring data. ... Applicant

argues that nowhere does Bisbee teach the feature of verifying that the modification information is assured as being true. In column 14, lines 5-9 it is explained that an original document can be checked by an authorized user, modified and then re-loaded back into the TCU. When the document is reloaded into the TCU all of the steps of an original e-original are taken. Therefore the modified document is verified to be a true.”

Applicant respectfully submits that Bisbee is seen at best to disclose appending to a digital document: the digital signature and certificate of the document submitter, a time stamp when a Trusted Custodial Utility (TCU) assumes control of the document, and a digital signature and certificate of the TCU.

The independent claims 1, 12, 18, and 20 include numerous features not discussed or disclosed in Bisbee. For instance, Bisbee fails to discuss or disclose, inter alia, ... “generating modification information that indicates how to modify the original data to obtain modified original data” as recited in claims 1 and 18 and “inputting ... modification information that indicates how to modify the original data to obtain modified original data” as recited in claims 12 and 20.

As best Applicant understands it, the “modified document” the Office Action refers to is an updated version of an e-original discussed in lines 5-18 of column 14 of Bisbee. Applicant respectfully notes that this updated version does not indicate how to modify any original data to obtain modified original data. For example, the updated version itself does not indicate how to modify the original e-original to obtain the updated version of the e-original. As best Applicant understands it, the updated version is merely a replacement for the original e-original and lacks any information that would indicate how the original e-original was modified to obtain the updated version. That is, the updated version appears to be the result of a modification, not something that indicates how to modify an original to obtain an update. In short, these lines of Bisbee at best discuss replacing one item with another, not modification information that indicates how to modify original data to obtain modified original data. In Bisbee, no “modification information” is seen to be “generated” or “input” in the manners variously defined by claims 1 and 18 and claims 12 and 20 respectively.

Bisbee also fails to discuss or disclose, inter alia, ... “creating modification-assuring-information for assuring that the modification information is true” and “outputting the original data, the original-data assuring information, the modification information, and the modification-assuring-information” as recited in claims 1 and 18.

As noted above, the Office Action asserts that: “In column 14, lines 5-9 it is explained that an original document can be checked by an authorized user, modified and then re-loaded back into the TCU. When the document is reloaded into the TCU all of the steps of an original e-original are taken. Therefor the modified document is verified to be a true.” However, the modified document, i.e. the updated version of the e-original, is not modification information. No modification information is seen in Bisbee. The updated version appears to be the result of a modification, not something that indicates how to modify an original to obtain an update. Thus, there is no modification information to assure as true in Bisbee. At the most, Bisbee merely applies a digital signature and certificate of the document submitter, but this does not assure any modification information as none is present. Rather, the digital signature and certificate is applied to the modified document, a result of a modification, not to any modification information that indicates how to modify original data to obtain modified original data.

No outputting of original data, original-data assuring information, modification information, and modification-assuring-information is seen in Bisbee. To the contrary, as noted in lines 5-7 of column 14 of Bisbee, “[a]n e-original in an account is replaced when an authorized party checks out and retrieves the e-original and submits an updated version” (emphasis added). Thus, the original e-original is not seen to be output with any modification information, as none is present. The original e-original is not seen to be output with the updated version either. Rather the updated version replaces the original e-original to become a new e-original. The digital signature and certification upon replacement appears to be that of the updated version, not the original e-original. Thus, any “original data” is apparently not output, but rather is replaced. At the most, Bisbee indicates that the original e-original is maintained and all activity tracked to discourage fraud (column 14, lines 11-13), but this seems to teach away from outputting of original data, original-data assuring information, modification information, and modification-assuring-information in the manners defined by claims 1 and 18.

Bisbee also fails to discuss or disclose, inter alia, ... “inputting the original data, original-data assuring information for assuring that the original data is an original, modification information that indicates how to modify the original data to obtain modified original data, and modification-assuring-information for assuring that the modification information is true” as recited in claims 12 and 20. Applicant again notes that in Bisbee the original e-original is replaced with an updated version. While the updated version may later be retrieved, there is no suggestion that it be retrieved along with the original e-original. At the most, the original e-original is maintained to track for fraud. Furthermore, even if both were retrieved, it would still fail to anticipate these features of claims 12 and 20 because, for example, neither the original e-original nor the updated version anticipates or even suggests the “modification information” recited in these claims.

Bisbee also fails to discuss or disclose, inter alia, ... “verifying, by the original-data assuring information, that the original data is assured as being an original” and “verifying, by the modification-assuring-information, that modification information regarding a modification of the original data is assured as being true” as recited in claims 12 and 20. At the most, Bisbee discusses digital signatures and certificates for an e-original. Even if it were assumed *arguendo* that two e-originals were assured in some sense, such would still fail to discuss or disclose these features of the claims because, for example, neither of the e-originals would anticipate any modification information nor include any modification-assuring-information as noted above.

Bisbee also fails to discuss or disclose, inter alia, ... “modifying the original data in accordance with the modification information to obtain the modified original data when it is verified that the original data is assured as being an original and the modification information is assured as being true” as recited in claims 12 and 20. There is no suggestion in Bisbee of “modifying the original data in accordance with the modification information to obtain the modified original data”. As the Office Action itself asserts, in Bisbee, a modified document is the item that gets reloaded into the TCU (Office Action, item 2). In Bisbee there is no need to modify the original e-original using any modification information because the original e-original gets replaced by the updated version. The only modification remotely suggested in Bisbee is that performed by a user

who retrieves and updates an e-original, but no modification information is generated as the updated version simply replaces the original. Thus, “modifying the original data in accordance with the modification information to obtain the modified original data when it is verified that the original data is assured as being an original and the modification information is assured as being true” as recited in claims 12 and 20 is not seen in Bisbee and moreover would appear to have no purpose in the replacement based scheme of Bisbee.

Furthermore, Applicant respectfully notes that the independent claims 1, 12, 18 and 20 recite both “original-data assuring information” and “modification-assuring-information” as distinct terms. Applicant respectfully submits that they should be treated as distinct features in the patentability analysis. As best Applicant can tell, the Office Action makes no distinction between them. For example, with respect to dependent claim 14 (which depends from claim 12) the Office Action finds that lines 25-28 of column 16 of “Bisbee teaches that the original data verifying means verifies a digital signature for the original data and the modification-information verifying means verifies a digital signature for the modification”. However, these lines of Bisbee appear merely to discuss the re-validation of an e-original. No modification is seen, merely a single re-validation, not two validations, much less “verifying, by the original-data assuring information, that the original data is assured as being an original” and “verifying, by the modification-assuring-information, that modification information regarding a modification of the original data is assured as being true” as defined by claim 14’s base claim.

The Office Action identified other instances of what it characterized as being modification information but which Applicant respectfully submits is not. In particular, the Office Action states: “Referring to claim 6, Bisbee teaches that the modification information includes information for identifying the original data, and the modification process performed when the original data was modified (column 17, lines 14-20” and “Referring to claim 7, Bisbee teaches that the modification information includes the

original data and difference information between the original data and modified data with respect to the original data (column 19, lines 18-20)".

Lines 14-20 of column 17 of Bisbee state: FIG. 4A depicts an exemplary object-inventory for a deal relating to a mortgage on property. It can be desirable to include in the object-inventory an abstract of the respective deal, and such an abstract may indicate a transaction number, an object-inventory number, the deal's type, value, subject matter, parties, etc., which are items of information that are typically useful in post-deal activities." Nothing therein is seen to discuss or disclose "modification information that indicates how to modify the original data to obtain modified original data" in as defined in either the independent claims or claim 6. Rather, upon modification, the modified deal is seen to simply replace its predecessor. Again, there is no suggestion of modification information. Rather, the updated deal is simply processed like its predecessor. Furthermore, there is no suggestion of any modification-assuring-information. Rather, any digital signature or certificate would appear to apply to the entire updated deal. Thus, there is no suggestion of both "original-data assuring information" and "modification-assuring-information". Applicant again respectfully submits that "original-data assuring information" and "modification-assuring-information" are distinct terms in claims 1, 12, 18, and 20 and should accordingly be treated as distinct features in the patentability analysis. Applicant likewise respectfully submits that "modification information" and "modified original data" are distinct terms in claims 1, 12, 18, and 20 and should accordingly be treated as distinct features in the patentability analysis.

The lines in column 19 cited in the Office Action merely provide another example of an object inventory that fails to discuss or disclose either modification information or modification-assuring-information for the same reasons discussed above with respect to column 17.

Applicant therefore respectfully submits that the independent claims 1, 12, 18, and 20 are patentable over Bisbee, and since each dependent claim incorporates all the features of its respective base claim by dependency, the dependent claims are likewise submitted to be patentable over Bisbee for at least the reasons provided above with respect to their respective base claims. The rejection of dependent claim 15 as allegedly

being unpatentable over Bisbee in view of Ginter relied on the alleged unpatentability of its base claim 1 over Bisbee. Applicant therefore submits that claim 15 is patentable over Bisbee in view of Ginter for at least the various reasons provided above with respect to the patentability of its base claim 1 over Bisbee.

### CONCLUSION

Applicant respectfully submits that all of the claims pending in the application meet the requirements for patentability and respectfully requests that the Examiner indicate the allowance of such claims at the Examiner's earliest convenience.

Any amendments to the claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If any additional fee is required, please charge Deposit Account Number 502456.

Should the Examiner have any questions, the Examiner may contact Applicant's representative at the telephone number below.

Respectfully submitted,

October 15, 2007

/Timothy J. Lane/

Date

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